

## REMARKS

Claims 1-53 are pending in the present application. In the above amendments, claims 1-5, 8-13, 15, 21, 24-28, 32-35, 38-43 and 46-49 have been amended, claims 18-20 have been canceled, and new claims 54-61 have been added. Therefore, after entry of the above amendments, claims 1-17 and 21-61 will be pending in this application. Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

### *Claim Amendments*

Independent claims 1, 8, 13, 21, 32, 38 and 43 have been amended to incorporate aspects of subject matter previously presented, for example, in original claims 2-3, 9-10, 33-34, as well as 39-40. Consequently, claims 2-3, 9-10, 33-34, as well as 39-40 have been amended for antecedent basis based on the introduction of the subject matter in the respective independent claim. Additionally, these amendments are fully supported throughout the specification. Thus, Applicants submit that no new matter has been added and that no new issues have been raised by these amendments.

Also, claims 1, 5, 8, 28, 32, 38 and 50 have been amended to correct typographical errors and/or to further define the existing subject matter. These amendments are fully supported throughout the specification.

Further, claims 4, 11-12, 15, 35, 41-42 have been amended to further define a timing and a precondition associated with the respective subject matter. These amendments are supported throughout the specification.<sup>1</sup>

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<sup>1</sup> Specification, pages 6 and 7.

Additionally, claims 9-10 and 39-40 have been amended to further define that the respective stated action is further based on a respective -- application menu request -- or -- application request --. This amendment is supported throughout the specification.

Also, claim 21 has been additionally amended to cancel superfluous wording from the preamble.

Finally, claims 24-27 and 46-49 have been amended to replace “is” with -- comprises --, thereby broadening these claims.

***Rejection under 35 USC § 103(a) based on Akins III and Minear***

The Examiner has rejected claims 1, 2-3, 5-6, 8-10, 12-14, 17, 18, 20-29, 31-34, 36-37, 38-40 and 42-53 under 35 USC § 103(a) as being obvious over US Patent Pub. No. 2004/0088180 to Akins III (“Akins III”) in view of US Patent Pub. No. 2003/0143991 to Minear et al. (“Minear”). The Applicants respectfully traverse this rejection.

Independent claims 1, 8, 13, 21, 32, 38 and 43 are patentable over any combination of the cited references, as the Examiner has failed to establish a *prima facie* case of obviousness for the claimed subject matter. The Examiner recognizes that Akins III “does not specifically teach . . . requesting a (sic) application menu from the remote server via wireless communication network, receiving the application menu from the remote server, displaying application menu to a user of the wireless device” or “requesting an application from the remoter server, receiving the application from the remote server, and activating the application.”<sup>2</sup> Notwithstanding this lack of disclosure in Akins III of the Applicants’ departure from the prior art, it is the Examiner’s position that it would have been obvious to one of ordinary skill in the art “to modify Akins’

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<sup>2</sup> Office Action, pages 7 and 8.

system to provide for . . . requesting . . . receiving . . . [and] displaying application menu . . . [and] requesting . . . receiving . . . and activating the application.”<sup>3</sup>

The Applicants respectfully disagree, however, as the Examiner has not provided a factual basis supporting a motivation to modify Akins III. Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation or suggestion in the reference to do so.<sup>4</sup> The PTO can satisfy this burden only by showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references.<sup>5</sup> Further, it is well settled that the mere fact that the prior art *could be* modified does not make the modification obvious unless the prior art has suggested the desirability of the modification.<sup>6</sup>

In the Office Action, the Examiner merely states that the recited subject matter is obvious in light of the cited references.<sup>7</sup> The Examiner does not provide any factual basis of any suggestion in the prior art for such a modification. This is an insufficient showing of motivation.

Additionally, the Applicants submit that no factual basis of any motivation or suggestion for the modification proposed by the Examiner exists in the references. Independent claims 1, 13 and 32 require, *inter alia*, “receiving, based on the sent peripheral device information [claim 13: sent driver information], at least one of an application menu and an application from the remote server” (emphasis added). Independent claims 8 and 38 require, *inter alia*, “transmitting, based on the sent peripheral device information [claims 38: sent identification information], at least one of an application menu and an application to the wireless device” (emphasis added).

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<sup>3</sup> *Id.*

<sup>4</sup> See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

<sup>5</sup> *Id.*

Independent claims 21 and 43 require, *inter alia*, “the transceiver further capable of *receiving* at least one of an application menu and an application *based on the transmitted peripheral device information*” (emphasis added). The Examiner admits that Akins III does not disclose or suggest requesting or receiving either an application menu or an application.<sup>8</sup> Further, the system and method of Minear involves updating versions of software applications on a wireless device based on comparing the listed versions of software in a wireless device summary file with the listed versions of software in a download server summary file.<sup>9</sup> Minear does not disclose or suggest receiving or transmitting at least one of an application menu and an application *based on sent peripheral device information* [or driver information or identification information from the peripheral device], as recited by independent claims 1, 8, 13, 21, 32, 38 and 43. Further, Minear does not disclose or suggest receiving or transmitting at least one of an application menu and an application, where the application menu and the application correspond to the peripheral device information [or driver information or identification information from a peripheral device], as recited by independent claims 1, 8, 13, 21, 32, 38 and 43. Accordingly, there is no factual basis in the evidence relied upon by the Examiner in rejecting independent claims 1, 8, 13, 21, 32, 38 and 43 to support the Examiner’s position that the claimed subject matter as a whole would have been obvious. The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art suggested the desirability of the modification.<sup>10</sup> Here, no such suggestion is found in the applied prior art. Thus, independent claims 1, 8, 13, 21, 32, 38 and 43 are patentable over the applied prior art.

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<sup>6</sup> *In re Gordon* (emphasis added).

<sup>7</sup> See, e.g., Office Action at page 4.

<sup>8</sup> Office Action, pages 7-8.

<sup>9</sup> Minear, Abstract; paragraphs 28-30; and Fig. 4.

<sup>10</sup> *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For the same reasons, claims 2-3, 5-6, 9-10, 12, 14, 17, 22-29, 31, 33-34, 36-37, 39-40, 42-53 are patentable over the applied prior art, as these claims respectively depend from one of independent claims 1, 8, 13, 21, 32, 38 and 43. Additionally, each of claims 2-3, 5-6, 9-10, 12, 14, 17, 22-29, 31, 33-34, 36-37, 39-40, 42-53 are independently patentable over the applied prior art as they independently recite subject matter not disclosed or suggested by the applied prior art.

Further, claims 18 and 20 have been canceled, and thus the rejection of these claims is now moot.

Therefore, based on these remarks, the Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 2-3, 5-6, 8-10, 12-14, 17, 18, 20-29, 31-34, 36-37, 38-40 and 42-53 under 35 USC § 103(a) as being obvious over Akins III in view of Minear.

***Rejection under 35 USC § 103(a) based on Akins III, Minear and Steele***

The Examiner has rejected claims 4, 11, 15, 19, 35 and 41 under 35 USC § 103(a) as being obvious over US Patent Pub. No. 2004/0088180 to Akins III (“Akins III”) in view of US Patent Pub. No. 2003/0143991 to Minear et al. (“Minear”) and further in view of US Patent No. 7,016,875 to Steele et al. (“Steele”). The Applicants respectfully traverse this rejection.

The deficiencies of the combination of Akins III and Minear are discussed above in detail, and this reasoning applies to claims 4, 11, 15, 35 and 41 as they depend from a respective one of independent claims 1, 8, 13, 32 and 38. Further, the addition of Steele does not solve these deficiencies.

Further, for the sake of argument, even if the combination of Akins III and Minear is considered valid, the Applicants submit that the Examiner has not provided any factual basis for modifying this combination with the teachings of Steele. Claims 4, 11, 15, 35 and 41 respectively deal with requesting or receiving a password prior to: “sending peripheral device

information to the remote server” (claims 4 and 35); “the transmitting of at least one of the application menu and the application to the wireless device” (claims 11 and 41); and “the downloading of the driver” (claim 15), as well as verifying the password as a precondition to the recited sending, transmitting or downloading. The Examiner admits that the combination does not disclose or suggest the use of a password.<sup>11</sup> Despite the admitted departure from the prior art, it is the Examiner’s position that it would have been obvious “to modify the combination to provide for the following: ...[reciting the admittedly missing subject matter]...as this arrangement would facilitate providing access to only authorized user as taught by Steele, thus protecting resources in a communication system.”<sup>12</sup> The system and method of Steele, however, only deals with sign-on access to an information account in a central data repository.<sup>13</sup> Steele does not disclose or suggest anything relating to “peripheral device information,” “a driver,” “an application menu and an application.” In addition, Steele does not disclose or suggest anything relating to verifying a password as a precondition to: “sending peripheral device information to the remote server” (claims 4 and 35); “the transmitting of at least one of the application menu and the application to the wireless device” (claims 11 and 41); “the downloading of the driver” (claim 15); and “the transmitting of the driver” (claim 19). Accordingly, there is no factual basis in the evidence relied upon by the Examiner in rejecting claims 4, 11, 15, 19, 35 and 41 to support the Examiner’s position that the claimed subject matter as a whole would have been obvious. The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art suggested the desirability of the modification.<sup>14</sup> Here, no such suggestion is found in the applied prior art. Thus, claims 4, 11, 15, 19, 35 and 41 are patentable over the applied prior art.

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<sup>11</sup> Office Action, page 9.

<sup>12</sup> *Id.* at page 10.

<sup>13</sup> Steele, Abstract.

Further, claim 19 has been canceled, and thus the rejection of this claim is now moot.

Therefore, based on these remarks, the Applicants respectfully request that the Examiner withdraw the rejection of claims 4, 11, 15, 19, 35 and 41 under 35 USC § 103(a) as being obvious over Akins III in view of Minear and further in view of Steele.

***Rejection under 35 USC § 103(a) based on Akins III, Minear and Lunsford***

The Examiner has rejected claims 7, 16 and 30 under 35 USC § 103(a) as being obvious over US Patent Pub. No. 2004/0088180 to Akins III (“Akins III”) in view of US Patent Pub. No. 2003/0143991 to Minear et al. (“Minear”) and further in view of US Patent No. 6,982,962 to Lunsford et al. (“Lunsford”). The Applicants respectfully traverse this rejection.

The deficiencies of the combination of Akins III and Minear are discussed above in detail, and this reasoning applies to claims 7, 16 and 30 as they depend from a respective one of independent claims 1, 13 and 21. The addition of Lunsford does not solve these deficiencies.

Further, for the sake of argument, even if the combination of Akins III and Minear is considered valid, the Applicants submit that the Examiner has not provided any factual basis for modifying the combination with the teachings of Lunsford. Claims 7, 16 and 30 respectively deal with communication or receiving peripheral device information via infra-red signals. The Examiner admits that the combination does not disclose or suggest communication or receiving peripheral device information via infra-red signals.<sup>14</sup> Despite the admitted departure from the prior art, it is the Examiner’s position that it would have been obvious “to modify the combination to provide for the following: ...[reciting the admittedly missing subject matter]...as this arrangement would provide one of the communication methods, among many possible

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<sup>14</sup> *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

<sup>15</sup> Office Action, page 10.

communication methods, for communication with other device as taught by Lunsford.”<sup>16</sup> The system and method of Lunsford, however, only deals with selecting a network access provider.<sup>17</sup> Lunsford does not disclose or suggest anything relating to “peripheral device information,” as recited by these claims. Furthermore, Lunsford does not disclose or suggest anything relating to “receiving, based on the sent [or transmitted] peripheral device information [or driver information], at least one of an application menu and an application,” as recited by these claims. Accordingly, there is no factual basis in the evidence relied upon by the Examiner in rejecting claims 7, 16 and 30 to support the Examiner’s position that the claimed subject matter as a whole would have been obvious. The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art suggested the desirability of the modification.<sup>18</sup> Here, no such suggestion is found in the applied prior art. Thus, claims 7, 16 and 30 are patentable over the applied prior art.

Therefore, based on these remarks, the Applicants respectfully request that the Examiner withdraw the rejection of claims 7, 16 and 30 and 42-53 under 35 USC § 103(a) as being obvious over Akins III in view of Minear and further in view of Lunsford.

### *New Claims*

The Applicants have added new claims 54-61 to recite subject matter to which they are entitled. These new claims are fully supported throughout the specification.<sup>19</sup> Further, these new claims merely further define existing subject matter, and thus no new issues have been raised.

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<sup>16</sup> *Id.* at page 10.

<sup>17</sup> Lunsford, Abstract.

<sup>18</sup> *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

<sup>19</sup> *See, e.g.*, Specification at page 6, paragraph 24.



New claims 54-61 depend from a respective one of independent claims 1, 8, 13 and 21, and thus claims 54-61 are patentable over any combination of the cited references for the same reasons as stated above.

Additionally, claims 54, 56, 58 and 60 are independently patentable, as no combination of the applied prior art discloses or suggests requesting or transmitting the application menu based on a determination that the peripheral device is activated, as recited by these claims.

Similarly, claims 55, 57, 59 and 61 are independently patentable, as no combination of the applied prior art discloses or suggests receiving or transmitting the driver together with the application menu.

Thus, the Applicants respectfully request that the Examiner allow new claims 54-61.

### CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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